

### **REMARKS**

By the foregoing Amendment, Paragraphs [0033] and [0038] of the Specification, Claims 1 and 14 and Figures 3-5 are amended. Entry of the Amendment, and favorable consideration thereof, is earnestly requested.

Claims 1, 8, 9, 11, 14 and 22 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,814,714. Claims 1 and 14, both independent claims, have been amended to require, among other elements, an insufflation device, that the second instrument part be connected, via a tube, to the insufflation device, and that the heating device be disposed in either the first instrument part or the second instrument part. Applicant respectfully submits that none of these elements are disclosed, taught or suggested by the claims of U.S. Patent No. 6,814,714. As such, Applicant respectfully traverses the double patenting rejection.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) as not including all reference characters mentioned in the description. Specifically, the Examiner has noted reference characters "g" and "1". With respect to reference character "g", Applicant respectfully points out that this reference character is not the letter "g", but rather is the number "9". Figures 3-5 have been amended to clarify this confusion. Applicant notes that reference character "9" is used at least in Paragraph [0036] of the specification as originally filed. With respect to reference character "1", Applicant notes that this reference character is used at least in Paragraph [0031] of the specification as originally filed.

The drawings are also objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Examiner has objected to the two temperature sensors 7 and the first instrument A not being

shown in Figure 5. Figure 5 has been amended to show these elements, and Paragraph [0038] of the specification is amended accordingly. Applicant respectfully submits that no new matter is being added.

Figure 5 has also been amended to show the insufflation device 12 and the tube 13 connecting the insufflation device 12 to the second instrument, since these elements are being added to Claims 1 and 14 by the Amendments presented herein. Paragraph [0033] is also being amended accordingly. Applicant respectfully submits that no new matter is being added, as these elements are disclosed, among other places, in Paragraphs [0014] and [0033] of the specification as originally filed.

Claims 1, 4-11, 14-17 and 19-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Drapeau et al. (U.S. Patent No. 4,682,010). Applicant respectfully asks the Examiner to reconsider these rejections in view of the above Amendments and the below Remarks.

The present invention, as claimed, is directed to an endoscopic instrument which includes a first instrument part adapted for introduction into a cavity of a human body and having an introduction channel therein for passage of gas therethrough, an insufflation device, and a second instrument part having a connection channel therein adapted to be connected to the first instrument part introduction channel, the second instrument part being connected, via a tube, to the insufflation device to provide gas, at a flow rate suitable for insufflation of a human body cavity. A heating device for heating the gas in the introduction channel to substantially the temperature of the human body is provided in at least one of the first instrument part and the second instrument part.

Applicant respectfully submits that Drapeau et al. does not disclose, teach or suggest at least the above-highlighted elements, which are required by all pending claims.

Drapeau et al. discloses an in-line heater for a nebulizer, ventilator or respirator system. The in-line heater has an elongated air flow tube in which is positioned a spiral mesh heating element. The mesh heating element is connected to a pair of terminal leads at opposite ends of the tube to power the heater. The heater is a disposable unit, and it may contain one or more disposable thermostats or other temperature sensors. The in-line heater is disclosed and described in the environment of a nebulizer system having a disposable in-line heater, a water bottle heater and a coordinated controller for controlling moisture content and water droplet size as a function of the water outlet temperature and the aerosol temperature to the patient.

Thus, Drapeau et al. does not disclose, teach or suggest an endoscopic instrument. Rather, Drapeau et al. discloses only a nebulizer, ventilator or respirator system, which no one skilled in the art would consider as being equivalent to an endoscopic instrument. Moreover, Drapeau et al. does not disclose, teach or suggest in any way an insufflation device, or an instrument part having a connection channel therein adapted to be connected to a first instrument part introduction channel, the second instrument part being connected, via a tube, to the insufflation device to provide gas, at a flow rate suitable for insufflation of a human body cavity. Again, Drapeau discloses only a nebulizer, ventilator or respirator system. As is well known, these devices are used to deliver pulmonary medications to a patient and/or assist a patient to breath. One skilled in the art would clearly understand that such systems are not insufflation devices, do not include insufflation devices, and do not relate in any way to insufflation of a human

body cavity. As such, Applicant respectfully submits that Drapeau et al. does not anticipate either of Claims 1 and 14, as amended.

Moreover, Applicant respectfully submits that Drapeau et al. does not render the present invention, as claimed, obvious. It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that there is absolutely no suggestion or motivation provided in Drapeau et al. to modify the device disclosed therein to be an endoscopic device which includes an insufflation device for insufflation of a human body cavity.

Claims 1, 4-9, 12, 14-17 and 19, 20 and 23 stand rejected under 35 U.S.C. §102(e) as being anticipated by Semm (U.S. Patent No. 5,362,310). Applicant respectfully asks the Examiner to reconsider these rejections in view of the above Amendments and the below Remarks.

Semm, like the present invention, is directed to an endoscopic instrument that includes an insufflator for insufflation of a human body cavity, which attempts to solve the problem of causing hyperthermia by the insufflation of relatively cool gasses. In order to achieve this goal, Semm discloses the use of an additional heatable tube that connects the actual insufflation device to the instrument to be inserted into the human body. It should be noted that Semm is assigned to Wisap, Sauerlach, and appears to be directed to the very "Flow-Therme" device discussed in the Background section of the specification as originally filed.

It should also be noted that Claims 1 and 14, all independent claims, have been amended such that they now require (i) a first instrument part for introduction into a body cavity, (ii) a second instrument part connected to the first instrument part, (iii) a tube connected to the second instrument part, (iv) an insufflation device connected to the tube, and (v) a heating element disposed in either the first instrument part or the second instrument part. Thus, all claims of the present invention require that the heating element be disposed in an instrument part that is separated from the insufflation device by a tube.

Applicant respectfully submits that such a configuration is not disclosed, taught or suggested in any way by Semm. While Semm may be considered as disclosing a first instrument part (i.e., Vetess needle 19) for introduction into a body cavity, a second instrument part (i.e., torsional coupling 18) connected to the first instrument part, a tube 10 connected to the second instrument part, an insufflation device 8 connected to the tube, and a heating element 11, Semm specifically discloses that the heating element 11 is disposed within the tube 10, **not** within the first instrument part or the second instrument part, as is required by all claims, as amended. Moreover, applicant respectfully submits that the tube 10 of Semm could not be considered as being the claimed second instrument part, because all claims require that there be a tube disposed between the second instrument part and the insufflation device, and if the tube 10 of Semm were considered to be the second instrument part, there would be no such intermediary tube.

Moreover, Applicant respectfully submits that it would not have been obvious to one skilled in the art to have modified Semm to have arrived at the present invention, as claimed. As discussed above, it is well settled that the mere fact that references can be combined or modified does not render the resultant

combination obvious unless the prior art also suggests the desirability of the combination or modification. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). It is also well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In the present case, Applicant respectfully submits that not only is there no suggestion or motivation provided in Semm to dispose the heating element in a second instrument part separated from the insufflation device by a tube, but that Semm explicitly teaches away from such a modification. More specifically, Semm teaches that the heating element must be disposed in the hose connected directly to the insufflator, as this is the entire crux of the Semm invention. (See, e.g., Column 3, Lines 3-5, which states "The heating hose is therefore connected with a length of 2 to 2.4 m directly to the outlet nipple of the insufflator."; Column 4, Lines 32-33, which states "In FIG. 2 the heating hose 10 is fitted directly to an insufflator 8 and namely to its gas connection 9."). Applicant respectfully submits that one skilled in the art would certainly not modify a reference with a primary teaching of disposing a heating element in a tube, so as to remove the heating element from the tube and locate it elsewhere.

In view of the fact that Claims 1 and 14 are now in condition for allowance, Applicant respectfully submits that withdrawn Claims 2, 3, 13, 18 and 24, which depend, either directly or indirectly, from either Claim 1 or Claim 14, should be entitled to consideration and are also in condition for allowance.

Response to Official Action  
Application No. 10/761,975  
Page 16

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1-24, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,



---

Wesley W. Whitmyer, Jr., Reg. No. 33,558  
Todd M. Oberdick, Reg. No. 44,268  
ST. ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, Connecticut 06905-5619  
(203) 324-6155  
Attorneys for Applicant

**Amendments to the Drawings:**

The attached sheet of drawings includes changes to Figures 3, 4 and 5. This sheet, which includes Figures 3, 4 and 5, replaces the original sheet including Figures 3, 4 and 5. A sheet showing the changes made to the drawings is also included herewith.

Attachments:        Replacement Sheet  
                             Sheet Showing Changes Made



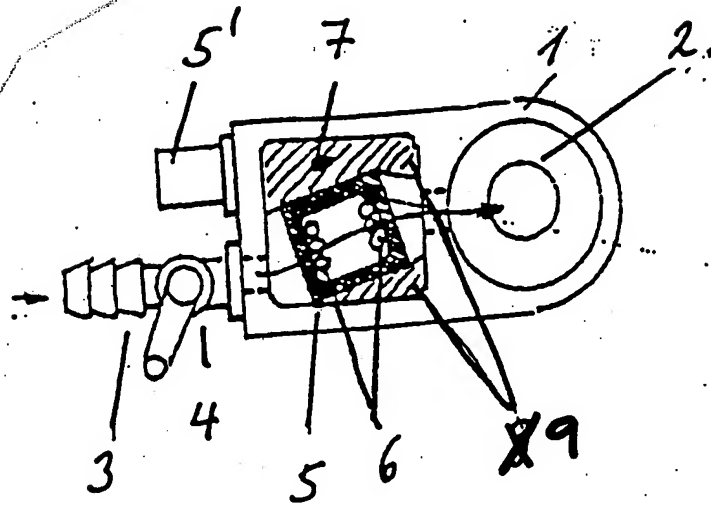
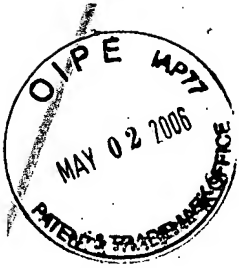


Fig. 3

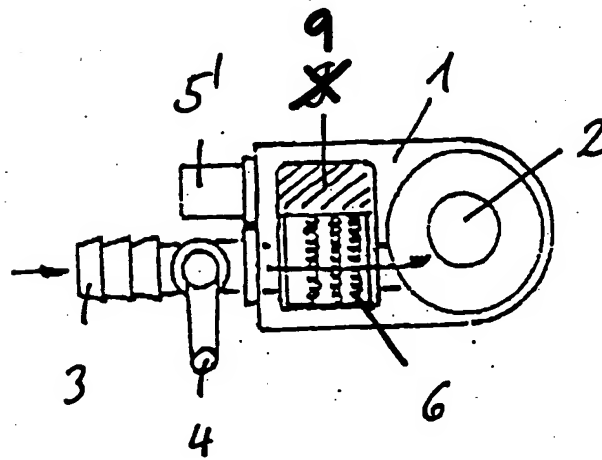


Fig. 4

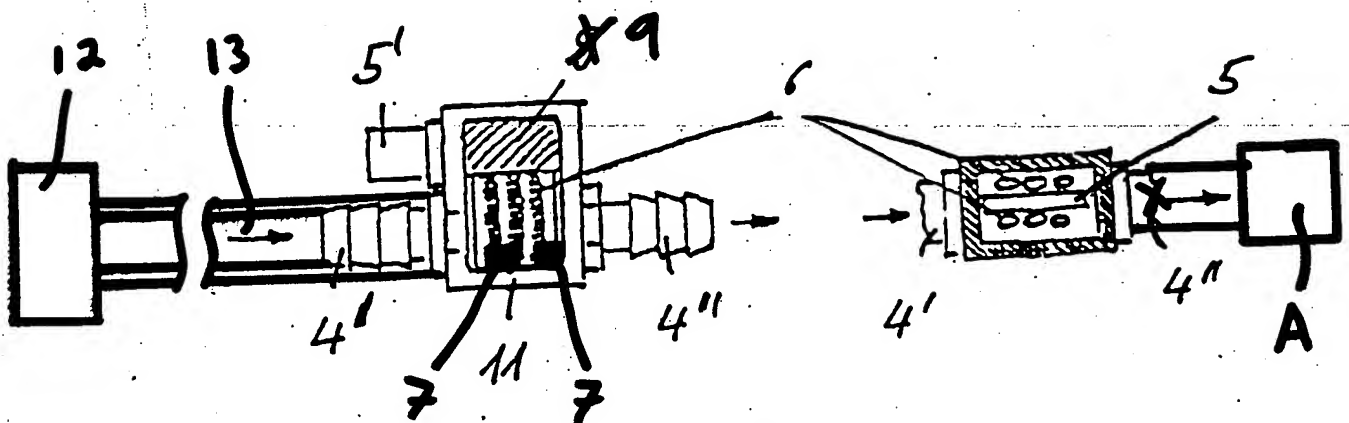


Fig. 5